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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,647	12/05/2003	Jerry Brower	2295-003	8426

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/728,647

Applicant(s)

BROWER ET AL.

Examiner

Daniel Zirker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner notes for the record that provisional application SN 60/170,477 was filed on December 13, 1999 and appears to be enabling for at least the three independent claims 1, 18 and 22 that are presently pending. The Examiner notes that the admission made in the parent application SN 10/618,166 in paragraph 7 of the Brower Declaration that the claimed device was "on sale" as early as 1999 does not, in view of the enabling disclosure of the provisional application, make such activity a statutory bar, despite comments to the effect that such might be the case, made earlier in this parent application. However, applicants should carefully check all of their pending dependent claims since there exists the possibility that some of these claims will not be entitled to the date of the provisional application.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-11 and 18-23 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. More particularly, the Brower Declarations in the present application (paragraph 5) and in parent application SN 10/618,166 (paragraph 10) appears to state that the presence of an aperture (present application) and (parent application) the presence of uneven or feathered serrations are each critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA

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1976). Accordingly each of the independent claims should be amended in a manner to be sure that both of these limitations are included therein.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,3,4,and 22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Owens et al. The reference is herein relied upon for disclosing (note particularly the Abstract, Fig 2, Col 1, line 58-Col 2, line 16, lines 51-58, Col 3, lines 11-36, Col 4, lines 19-24) a repair patch that can comprise a substantially planar plastic sheet made from, e.g. polyester or polypropylene, having an adhesive layer 15 on one outer surface and a ready to paint (Col 2, lines 10-12) opposing outer surface, or one which is inherently ready to paint or at most a minor modification within the skill of the art to make it so. As regards the presence of a textured ready to paint surface (claim 3) and a tear resistant plastic (claim 4) these are each believed to be either inherent in the disclosed plastic patches, or at most an obvious modification to one of ordinary skill.

7. Claims 5-11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson taken either individually, or in view of Owens et al, and for all the claims in further view of Parker '222, the latter reference being taken as evidence of the state of the art, substantially for reasons set forth in Paragraph No. 11 of Paper No. 021406, together with the following additional observations. Swanson, as admitted by

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applicants, substantially discloses the various claimed inventive embodiments except for the presence of an aperture formed through the wall patch. However, this is believed to be either taught or rendered obvious by Owens et al (e.g. Col 3, lines 14-15), with the limitations in claims 6-8 and relating to apertures which are sized to enclose a wall element again shown to be known to one of ordinary skill by the disclosure of Parker, and the presence of aperture reinforcements (claims 9-11) also believed to be put within the skill of the art by Parker. As regards the motivation for incorporating the apertures of Owens et al into Swanson it can only be noted that the presence of holes are well known elements in this art and there are many embodiments in which one might wish to have an opening for, e.g. an electrical outlet in a patch structure. Other parameters that are not either expressly or inherently disclosed by the various combinations are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-4, 18 and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,6 and 8 of U.S. Patent No. 6,607,621. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method claims of the Swanson patent render obvious all of the limitations of the claimed article inventions; i.e. a planar patch substrate having an adhesive on one outer surface and a ready to paint opposing second surface.

10. Claims 1-4, 18 and 22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 18,20, 30 and 31 of copending Application No. 10/618,166. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '166 application are virtually identical in both form and substance to the presently pending claims, disclosing or rendering obvious all of the claimed limitations..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 2 and 18-21 are not rejected on the basis of adverse prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday - Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571 - 272 - 1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker
Primary Examiner
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A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive style with a large, stylized 'Z'.